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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,601	11/12/2003	Tod E. Kuwahara	51319/ DRK/S850	9003
23363	7590	06/07/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			CHAU, MINH H	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			2854	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,601

Applicant(s)

KUWAHARA, TOD E.

Examiner

Minh H. Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 14, 16 and 25 is/are allowed.
- 6) ☒ Claim(s) 15, 17-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of **claims 15, 17-24 and 26-29** are withdrawn in view of further consideration to the reference(s) to Ogg et al. (Pub. No. US 2002/0073039A1 and in view of newly discovered reference(s) to Walz et al. (US # 5,325303). Rejections based on the above-cited reference(s) follow.

Claim Objections

2. **Claim 16** is objected to because of the following informalities: The rewritten independent Claim 16 is incompleted because it does not including all the limitations of the base claim. The missing recitation of "with postage indicia matches a label serial number in the software" should be added on line 7, right after "to be printed".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 15** is rejected under 35 U.S.C. 102(e) as being anticipated by Ogg et al. (Pub. No. US 2002/0073039A1).

With respect to **claim 15**, Ogg et al. teach a method for providing computer-based postage stamps or assisting a user with the proper printing of postage indicia onto labels in rolls of labels in a label printer comprising providing interactive computer software that guides a user to confirm that a serial number on a label in a roll of labels to be printed with postage indicia matches a label serial number in the software, the software queries the user as to a range of serial numbers of labels to be printed with postage indicia (see paragraph [0043-51] of Ogg et al.)

5. **Claims 17-19, 21-24 and 26-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Walz et al. (US # 5,325,303).

With respect to **claims 17 and 26**, Walz et al. teach a continuous form of labels or a roll of labels comprising an elongate carrier (30), a plurality of pre-printed label sets (34) on the elongate carrier, each pre-printed label set comprising a label body (44) and a leader (60), wherein each label body and leader bears the same unique serial number (see Fig. 2 and cols. 5-6 of Walz et al.)

With respect to the recitation of "*for further printing with postage indicia*" and "*for further printing with value bearing indicia*" in the preamble of claims 17 and 26, the above recitation is for intended use only and also the scope of claims 17 and 26 are

mainly focused on the structures of the pre-printed label sets and the body of the claim language does not refer back any thing that related to the "printing with postage indicia" or "printing with value bearing indicia". Therefore, the Examiner does not give a patentable weight for these recitations.

With respect to **claims 18 and 27**, see Fig. 2 of Walz et al. that teach the leader (60) of each label set is adjacent to its respective label body (44).

With respect to **claims 19 and 28**, see Fig. 2 of Walz et al. that teach the serial number is located horizontally on the leader, and the serial number is located vertically on the label body.

With respect to **claim 21**, see Fig. 2 of Walz et al. that teach the leader (60) is divided into a serial number bearing portion (61) and a supplemental information bearing portion (62)

With respect to **claim 22**, see Fig. 2 of Walz et al. that teach the label bodies (44) are releasably attached to the elongate carrier.

With respect to **claim 23**, see Fig. 2 of Walz et al. that teach the leaders (60) comprise labels which are releasably attached to the elongate carrier.

With respect to **claim 24**, see Fig. 2 of Walz et al. that teach the leaders (60) comprise areas of the carrier upon which are directly printed the serial numbers (61).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 20 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz et al. as applied to claims 17-19, 21-24 and 26-28 above.

With respect to **claims 20 and 29**, Walz et al. teach a continuous form of labels or a roll of labels comprising the serial number (61) is located horizontally on the leader (60), and the serial number (67) is located vertically on the label body (44) (see Fig. 2 of Walz et al.)

Walz et al. teach all the claimed invention except for the recitation of *"the serial number is located horizontally on both the leader portion and the label body."* I would have been obvious to one having skill in the art at the time the invention was made to modify the label sets of Walz et al. to include the serial number is located horizontally on both the leader portion and the label body, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. the above modification is for the advantage of allowing the user to easily to comparing and confirming the serial number between the leader portion and the label body portion.

Allowable Subject Matter

8. **Claims 1-12, 14 and 25** are allowed.

Claim 16 would be allowable if rewritten to over come the objection above which including all of the limitations of the base claim.

Response to Remarks

9. Applicant's remarks with respect to **claims 17-24 and 26-29** have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H. Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHC
June 02, 2005


MINH CHAU
PRIMARY EXAMINER